

and 11 stand rejected under §103(a) as being unpatentable over *Graf et al.* in view of *Kagami et al.*

Applicant respectfully traverses each of the §103 rejections as the Office Action fails to respond to Applicant's previous arguments presented in the Office Action Response filed on September 24, 2002. The Office Action does not address Applicant's arguments with respect to the impropriety of the proposed combination. The Office Action fails to present specific evidence of where the '400 reference teaches the limitations of the claimed invention, in claim 1, for example, the colored article, colored structure, and item. M.P.E.P. 707.07(f) dictates that the Office Action should take note of the Applicant's argument regarding the impropriety of the cited references and the asserted combination and answer the substance of it. This is consistent with the purpose of aiding the Applicant in judging the propriety of continuing the prosecution, as indicated in 37 C.F.R. §1.104(a)(2). Evidence of complete correspondence has not been presented in support of the Examiner's proposed combination. The Office Action does not comply with this requirement, and Applicant requests that the §103 rejections be withdrawn.

The cited combination of references does not teach or disclose all aspects of the claimed invention. Claim 1 of the instant invention is directed to a system for on-line viewing of an article on another structure including, for example, the computer-driven web-linking engine adapted to compare color codes identifying respectively colored objects (e.g., claimed article and structure) to satisfy a color-matching criterion. The Office Action acknowledges at page 3 that the '400 reference fails to teach comparison of color codes identifying respective colors of such related objects. The Office Action then attempts to overcome this deficiency by alleging that the '300 reference teaches the comparison of color codes. But neither reference, alone or in combination with the other, teaches the comparison of color codes for two similarly colored products or, of even comparing two colored products. Rather, the proposed combination merely teaches matching one colored product to a standard color code. Without such correspondence, the §103 rejections cannot be maintained, and Applicant requests that the rejections be withdrawn.

Applicant further submits that the Office Action fails to present evidence of motivation in support of the modification of the '400 reference with the '300 reference. Evidence has not been provided of any teaching or suggestion for using the '400 reference in connection with viewing more than one item and comparing the respective color codes of two products, as claimed in the instant invention, or for modifying the reference to achieve the claimed limitations. Recent case law indicates that evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification. "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'" Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 U.S.P.Q.2d (Fed. Cir. 2000). The Office Action fails to identify any evidence of why one skilled in the art would be led to modify the '400 reference, and does not provide any evidence of factual teachings, suggestions or incentives from the prior art that lead to the proposed modification. Applicant requests that the rejections be withdrawn.

Moreover, the §103 rejections are improper because the proposed modification would undermine the purpose and operation of the '400 reference. The '400 reference is directed to addressing a need for passing personal preferences, where a high degree of secrecy is essential. *See*, col. 6, lines 42-44. In order to address this need, the '400 reference teaches allowing the client to enter personal data encoded to shield the content from a server which is passed through a server to an expert. The expert then issues an opinion that is returned to the client for evaluation. The '400 server intentionally does not provide any evaluation or comparison because it does not have rights to access the client's personal preference data. Rather, the server acts merely as a conduit for the expert.

The Office Action proposes modifying the '400 reference such that the color comparison technique of the '300 reference is performed by the server. This server-related function would require that the server have access to the client's personal preference data. Such access is in direct opposition to the purpose of the '400 reference.

Because this modification would require the server to read the client data in order to make the comparison, this modification would directly undermine the essential secrecy of the client's data as taught by the '400 reference. To allege under §103 that a skilled artisan would modify the '400 reference in such a manner is untenable and impermissible under §103. *See, e.g., In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (A §103 rejection cannot be maintained when the asserted modification undermines the purpose of the main reference.)

Further, to modify the '400 reference by inserting the color comparison technique of the '300 reference, the '400 reference would not function as alleged, for example, in Figures 7 and 8. As discussed above, the color comparison of the '300 reference would match a selected color (*e.g.*, white) with a color standard for white, thereby replacing the left portion of the screen illustrated in Figures 7 and 8. Thus, the proposed modification would not only undermine the purpose, but also undermine the operation of the '400 reference. *See, e.g., In re Gordon*.

Moreover, the Office Action cites an inapplicable patent office decision as a substitute for evidence of motivation. Unlike the claimed invention, the cited decision involved an instance of duplication of parts. In accordance with the above discussion regarding the lack of correspondence between the claimed invention and the cited references, the issue here is not duplication of parts but, rather, lack of correspondence. In regards to the claimed invention, Applicant fails to see which parts are allegedly duplicated. The facts in the cited case are not sufficiently similar to the instant application. *See, M.P.E.P. §2144*. Because the Examiner has not presented any relationship between the allegation of duplication and the claimed invention, this Office Action citation is irrelevant and inapplicable.

Applicant also traverses the finality of the instant Office Action. The Examiner has presented new rejections to which Applicant is entitled to respond. The §103(a) rejection of claims 1, 2, 5-9 and 12-16 has not been previously asserted. Applicant requests that the finality of the rejection be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC  
1270 Northland Drive, Suite 390  
St. Paul, MN 55120  
651/686-6633

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By: 

Robert J. Crawford  
Reg. No. 32,122